

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:) Attorney Docket No.: F-521
) Customer No.: 00919
John F. Braun, et al.)
) Examiner: ROBINSON, Myles D.
Serial No.: 10/065,281) Group Art Unit: 2625
Filed: September 30, 2002)
Confirmation # 5695) Date: March 19, 2008

Title: METHOD AND SYSTEM FOR CREATING AND SENDING A
 FACSIMILE USING A DIGITAL PEN

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
PO BOX 1450
Alexandria, Virginia 22313-1450

Sir:

 This communication is submitted in response to the December 19, 2007 Final Office Action ("Office Action"). A Notice of appeal is filed concurrently herewith. Consideration of the enclosed remarks is respectfully requested.

 The following sections are enclosed:

1. Statement in Support of Pre-Appeal Brief Request For Review

Statement in Support of Pre-Appeal Brief Request For Review

Claims 1-20 are pending in the Application. The Final Rejection is newly presented and this paper is the first opportunity for Applicants to respond to the newly cited references. Applicants respectfully requests that the panel find that the application is in condition for allowance or remove the finality of the Final Office Action.

Independent Claim 16 and Dependent Claim 20

16. A system for sending a facsimile of a message comprising:
a receiver to receive pen stroke data and user identification data
from a digital pen including attachment data indicating at least one
attachment;
a processor to process pen stroke data; and
a file server connected to the processor, wherein the processor
uses pen stroke data and the user identification data to locate the at
least one attachment and uses pen stroke data to verify permission to
access the at least one attachments;
the processor further configured to compose the facsimile
message using the at least one attachment if permission to access the
at least one attachment is verified; and
the processor further configured to send the facsimile message.
20. The system of claim 16, wherein,
the processor uses the user identification data to verify
permission to access the at least one attachment.

Rejection under 35 USC § 102(e)

In section 6 of the Office Action, the Examiner rejected Claims 16 and 20 under 35 U.S.C. 102(e) as allegedly anticipated U.S. Patent Application Publication No. 2003/0103238 by MacLean, et al. ("MacLean '238").

Applicants respectfully submit that the rejection is in error for at least the following reasons. The Examiner alleges that identifier 54 of MacLean '238 teaches user identification data as presently claimed. However, the cited paragraphs 0051, 0053, 0055 and 0060 clearly show that MacLean is describing an identifier of the document and not the pen user. In fact, when MacLean discusses the "author" in

paragraph 0053, MacLean is describing the author of the underlying document being annotated and not the user of the pen.

Moreover, the Examiner alleges that the printed identifier 59 used in MacLean satisfies the claim recitation of "the processor uses pen stroke data and the user identification data to locate the at least one attachment." However, it is clear that item 59 is pre-printed and certainly not affiliated with pen stroke data. Additionally, item 54 does not represent user identification data. Furthermore, the Examiner's reliance on multiple versions of the working document data in paragraph 0060 of MacLean are misplaced. Initially, there is no suggestion there of identifying attachments, but merely the same source document 60 being manipulated simultaneously by multiple users each having a working copy in memory for annotations. Moreover, there is no suggestion in the reference for using pen stroke data to verify permission to access the at least one attachments.

"To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2D (BNA) 1618, 1624 (Fed. Cir. 1996). Accordingly, the Examiner has not shown each element in the cited reference and thus has not established a prima facie anticipation rejection.

Independent Claim 1 and Dependent Claims 2, 3 and 9

1. A method for composing a facsimile message comprising:
 - capturing strokes made by a user with a pointing instrument that include indications of data including facsimile message data and command data;
 - processing the strokes in order to determine a recipient designated by the strokes,
 - determining a template for a cover page for the facsimile message using the strokes;
 - processing the strokes in order to determine an attachment identifier relating to at least one attachment requested for the facsimile message;

requesting the at least one attachment from a server that is remote from the pointing instrument using the attachment identifier;
receiving the at least one attachment from the server;
composing the facsimile message using the cover page template, the facsimile message data and the at least one attachment;
and
sending the facsimile message to the recipient.

2. The method of claim 1 wherein
the pointing instrument is a digital pen and strokes are provided by the user writing on a paper media having a pattern.

3. The method of claim 2 further comprising:
capturing user authentication information related to the user;
determining user identification data; and
wherein requesting the at least one attachment includes using the user identification data and the attachment identifier to identify the location of the attachment.

9. The method of claim 5 wherein
the pen stroke data includes the attachment identifier identifying the at least one attachment, further comprising:
identifying the at least one attachment using the biometric data;
authenticating the user using the user authentication information;
and
verifying user permission to access the at least one attachment file and stopping the facsimile message composition process if the user does not have permission to access the at least one attachment file.

Rejections under 35 USC § 103(a)

In section 6 of the Office Action, the Examiner rejected Claims 1-3, 6-8 and 12-16 under 35 U.S.C. 103(a) as allegedly anticipated U.S. Patent Application Publication No. 2003/0103238 by MacLean, et al. ("MacLean '238") in view of U.S. Patent No. 6,873,430 to Grasso, et al. ("Grasso '430") and further in view of U.S. Patent No. 7,094,977 to Ericson, et al. ("Ericson '977").

Applicants respectfully submit that the rejection is in error for at least the following reasons. On page 6, the Examiner is apparently referring to claim 11 and claim 1 under same rational as stated on page 11. Applicants reiterate as described above that identifier 54 of MacLean '238 does not teach user identification data as

presently claimed. Moreover, the cited reference does not teach or suggest “processing the strokes in order to determine an attachment identifier. With regard to claim 3, the cited references do not teach or suggest “using the user identification data to identify the location of the attachment.” No mention is made of using anything to determine the location of the attachment. Additionally, with regard to claim 9, as described above, there is no suggestion in the references for authenticating the pen user. Additionally, there is no suggestion for verifying user permission to access the attachment and stopping the composition process if the user is not authorized.

Claims 11, 12 and 14 are patentable over the cited references for the same reasons described above with respective similar claims 1, 3 and 9. The remaining dependent claims are patentable for at least the reasons described with reference to the corresponding independent and any intervening claims. Accordingly, the Examiner has not established a prima facie obviousness rejection.

Accordingly, Applicants respectfully request that the panel find that the invention as presently claimed in claims 1-20 is patentable and in condition for allowance.

Respectfully submitted,
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